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EXAMINER

GWARTNEY, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,480	Applicant(s) AL-ASSAF ET AL.	
	Examiner Elizabeth Gwartney	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20051212;20080114</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112/ 35 USC § 101

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6, 8-12 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6 and 8, the recitation "similar effects" renders the claim indefinite because it is unclear what "effects" the recitation is referring to or what is meant by similar.

Regarding claims 9 and 11, it is unclear what parameters are encompassed by the terms "consisting" and "comprising" in the same claim. Does that applicant mean that the dietary fiber material can only contain modified gum arabic or that it can contain other components in addition to gum arabic?

Claim 16 recites the limitation "the food or drink" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 10, 12 and 17-20 provide for the use of the modified gum arabic of claim 1, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claims 10, 12 and 17-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6 and 8-20 are rejected under 35 U.S.C. 102(a) as being anticipated by eFood-Ingredients (“Enzymes containing hexose oxidase can help reduce dough stickiness”).

Regarding claim 1, e-Food Ingredients disclose a water-soluble acacia - derived (i.e. modified gum arabic) having a total dietary fiber content measured by the AOAC method of more than 90 percent (p. 4/Gentle fibre/P1-2).

Regarding claim 2, e-Food Ingredients discloses all of the claim limitations as set forth above. While e-Food Ingredients disclose that the modified gum arabic has a high molecular weight (p. 4/Gentle fibre/P7), the reference does not explicitly disclose that the weight-average molecular weight is not less than 1 million. However, given that e-Food Ingredients discloses a modified gum arabic identical to that presently claimed, it is clear that it would inherently have a molecular weight of not less than 1 million.

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Regarding claims 3-4, e-Food Ingredients discloses all of the claim limitations as set forth above. Statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02. However, e-Food Ingredients does disclose that the modified gum arabic is incorporated into food (i.e. dairy, beverages, confectionary, bakery, processed fruits, frozen desserts and dietetic specialties) in order to increase the content of dietary fiber (p. 4/Gentle fibre/P9).

Regarding the method limitations recited in claims 5-6, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in *Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as a product of the prior art, the claim is unpatentable even though the prior

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product was made by a different process.). In the instant case, the modified gum arabic of claims 5-6 is the same as the modified gum arabic disclosed by e-Food Ingredients

Regarding claim 8, e-Food Ingredients disclose all of the claim limitations as set forth above. Given that e-Food Ingredients discloses a gum arabic-derived dietary fiber identical in properties to the one presently claimed, it is clear that it would have been prepared under conditions that make the product.

Regarding claims 9 and 11, e-Food Ingredients disclose all of the claim limitations as set forth above and a that the modified gum arabic is a dietary fiber material for food and drink (p. 4/Gentle fibre/P1,9). Given that e-Food Ingredients discloses a dietary fiber material that is added to food in order to increase the content of dietary fibre, it necessarily follows that the material is an additive. However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

Regarding claims 10, 12 and 17-20, e-Food Ingredients discloses all of the claim limitations as set forth above. e-Food Ingredients also discloses that the modified gum arabic is

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used as a dietary fiber material for food and drink and to increase the content of dietary fiber in food and drinks (p. 4/Gentle fibre/P9). Further e-Food Ingredients discloses that the dietary fiber material improves bowel movements, intestinal functions and intestinal conditions (p. 6/Gentle fibre/P5-7).

Regarding claims 13-15, e-Food Ingredients discloses all of the claim limitations as set forth above and a food and drink containing the modified gum arabic as a dietary fiber material (p. 4/Gentle fibre/P9). e-Food Ingredients also discloses that the material is incorporated into food in order to increase the content of dietary fiber (p.4/Gentle fibre/P6). Further e-Food Ingredients discloses that the dietary fiber material improves bowel movements, intestinal functions and intestinal conditions (p. 4/Gentle fibre/P5-7). Given that e-Food Ingredients discloses a food and drink containing the modified gum arabic as a dietary fiber material and that the dietary fiber material is beneficial for intestinal health, it necessary follows that the food and drink would be used for improving bowel movements, intestinal functions, and intestinal conditions.

However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product

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patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

Regarding claim 16, e-Food Ingredients discloses all of the claim limitations as set forth above and a method where the modified gum arabic is added to food and drink products to increase the content of dietary fiber (p. 4/Gentle fibre/P9).

However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

6. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Phillips et al. (US 2003/0027883).

Regarding claim 1-2, Phillips et al. disclose a water-soluble modified gum arabic which has a weight-average molecular weight of not less than 1 million ([0016],[0069]-[0079], p. 5/Table 1, p.6/Table 2).

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Given that Phillips et al. disclose a modified gum arabic having a weight-average molecular weight of not less than 1 million identical to that presently claimed, it is clear that the modified gum arabic would inherently have a total dietary fiber content measured by the AOAC method of not less than 90%.

Regarding claims 3-4, Phillips et al. disclose all of the claim limitations as set forth above. Statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02. However, in this case Phillips et al. disclose that the modified gum arabic can be used as a fiber to enhance bacterial fermentation in the colon for cholesterol and diabetic control (i.e. dietary fiber) and for the emulsification of oil in water systems for beverages ([0168], [0170]).

Regarding the method limitations recited in claims 5-6, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in *Thorpe*, 777 F.2d at 697, 227 USPQ at 966

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(The patentability of a product does not depend on its method of production. In *re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.). In the instant case, the modified gum arabic of claims 5-6 is the same as the modified gum arabic disclosed by Phillips et al.

Regarding claim 7, Phillips et al. disclose all of the claim limitations as set forth above and that the modified acacia gum is of *Acacia senegal* origin ([0069]).

Regarding claim 8, Phillips et al. disclose all of the claim limitations as set forth above. Phillips et al. also disclose a method for preparing the modified gum arabic where gum arabic is exposed to ionizing radiation in the presence of a mediating gas followed by a heat treatment at temperatures ranging from 40° C to 120° C (Abstract, [0018]-[0020]).

Regarding claims 9 and 11, Phillips et al. disclose all of the claim limitations as set forth above. Phillips et al. also disclose that and that the modified gum arabic is used in medicine and food and as a fiber to enhance bacterial fermentation in the colon for cholesterol and diabetic control (i.e. dietary fiber) (Abstract, [0168], [0170]). Given that Phillips et al. disclose a modified gum arabic identical to that presently claimed (i.e. modified gum arabic having a total dietary fiber content of not less than 90%), it is clear that it would inherently be a dietary fiber material or an additive. However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of

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performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

Regarding claims 10, 12 and 17-20, Phillips et al. disclose all of the claim limitations as set forth above and that the modified gum arabic is used in medicine, food and drink and as a fiber to enhance bacterial fermentation in the colon for cholesterol and diabetic control (i.e. dietary fiber) (Abstract, [0168], [0170]).

Regarding claims 13-15, Phillips et al. disclose all of the claim limitations as set forth above and a drink containing the modified gum arabic ([0168]). Phillips et al. also disclose that the modified gum arabic is a high molecular weight fiber used to enhance bacterial fermentation in the colon for cholesterol and diabetic control (i.e. dietary fiber)([0170]). Given that Phillips et al. disclose a drink containing the modified gum arabic that is a dietary fiber and that the dietary fiber material is beneficial for health, it necessary follows that the food and drink would be used for reducing blood cholesterol levels and controlling blood-sugar levels.

However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473,

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1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

Regarding claim 16, Phillips et al. disclose all of the claim limitations as set forth above and method where the modified gum arabic is added to drink products and that the modified gum arabic is a fiber used for cholesterol and diabetic control ([0168], [0170]).

However, statements in the preamble reciting the purpose or intended use of the claimed invention which do not result in a structural difference between the claimed invention and the prior art do not limit the claim and do not distinguish over the prior art invention. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein, as it has been held that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). See also MPEP § 2111.02 and § 2112 - § 2112.02.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over e-Food Ingredients ("Enzymes containing hexose oxidase can help reduce dough stickiness").

Regarding claim 7, e-Food Ingredients disclose all of the claim limitations as set forth above. While e-Food Ingredients disclose a gum arabic (i.e. acacia) derived dietary fiber (p.4/Gentle fiber), the reference does not explicitly disclose that the dietary fiber is of *Acacia senegal* origin.

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Given that e-Food Ingredients disclose gum arabic (i.e. acacia) broadly, absent evidence to the contrary, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have specifically used any source of gum arabic (i.e. acacia) including *Acacia senegal* to arrive at the current invention.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Thursday; 7:30AM - 5:00PM EST, working alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794